

REMARKS

In the Official Action mailed 5 May 2005, the Examiner reviewed claims 1-27. The Examiner objected to the drawings; objected to the specification and rejected claims 1-27 under 35 U.S.C. §102.

Objection to Drawings

The Examiner has objected to Figure 1 because the connector is not labeled. Reference number 17 has been added to the connector in Figure 1. Replacement sheets are attached to this Response.

Objection to Specification

The Examiner objected to informalities of a misstated reference number on page 7. Applicants have submitted a replacement paragraph making this correction.

Rejection of Claims 1-27 under 35 U.S.C. §102(e)

Claims 1-27 are rejected under 35 U.S.C. §102(e) as being anticipated by Hwang et al., U.S. Pub. No. 2002/0188875A1 (the '875 Published Application). Reconsideration is respectfully requested

The current patent application has a filing date of August 29, 2001, which predates the filing of '875 Published Application on April 24, 2002, but postdates the filing of the provisional application no. 60/286,320 on April 24, 2001 (Hwang Provisional) of which the '875 Published Application claims the benefit. Apparently, the Examiner is relying on the filing date of the Hwang Provisional, as the basis for the rejection. However, in order to rely on the filing date of the Hwang Provisional, the features relied upon by the Examiner must be described in the provisional application. It is not sufficient that the '875 Published Application describes them.

As a basis for the rejection, the Examiner cites paragraph 0078 and Figure 6 in the '875 Published Application, as corresponding to the element of claim 1 reading:

*“power management logic which forces the medium interface unit to the lower speed protocol in response to an event signally entry of said lower power mode”.*

The cited passage in the '875 Published Application describes that the firmware configures the PHY to only advertise a slower speed (10 Mbit or 100 Mbit). However, our review of the Hwang Provisional did not find the specific claimed features. There are some

general discussions in the Hwang Provisional about power management registers on pages 45, 63, and 152-154 but we do not find the description relied upon by the Examiner.

M.P.E.P. 706.02V(D) states what constitutes the effective filing date of an application claiming the benefit to a provisional application: the effective filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application. Furthermore, M.P.E.P. 706.02(f)(1) further states that a potential reference that claimed the benefit of a provisional U.S. application under 35 U.S.C. 119(e) in which the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e).

Claim 1 recites a computer system comprises a host processor, including resources supporting a full power mode, a lower power mode and a power down mode; and a network interface coupled to the host processor and to a network, the network interface comprising: a memory that stores data packets in transit between the host processor and the network; a medium interface unit coupled to network media supporting at least a high speed protocol and a lower speed protocol; and power management logic which forces the medium interface unit to the lower speed protocol in response to an event signally entry of said lower power mode. (Emphasis added).

The Hwang Provisional does not disclose this claimed feature, and the cited passage in the '875 Published Application by the Examiner in paragraph 78 was added when the '875 Published Application was filed on April 24, 2002, which is after the filing date in the present application, August 29, 2001. The Hwang Provisional is directed toward integrated gigabit Ethernet PCI-X controller with the specification provided from a preliminary data sheet. The three original names inventors for the Hwang Provisional, Jennifer Y Chaio, Myles H. Wakayama, and Gary A. Alvstad are no longer listed as inventors in the '875 Published Application.

The Examiner also cited paragraph 78 in the Hwang Provisional as the basis for rejecting independent claims 10 and 19. Claim 10 includes similar limitations as Claim 1 by reciting in a network interface apparatus coupled to a bus system having a full power mode, a lower power mode and a power off mode, and supporting a plurality of protocols including a high speed protocol and a lower speed protocol, a method of power management, comprises forcing the apparatus to execute the lower speed protocol upon transition from the full power mode to the

lower power mode using logic independent of host processes. Claim 19 also includes similar limitations as Claim 1 by reciting an integrated circuit for use in a network interface between a host processor and a network, the host processor including system bus having a full power mode, a lower power mode and a power down, comprising: a first port that receives data from the host processor; a second port that transmits data to the network; a memory that stores data packets in transit between the host processor and the network; a medium interface unit coupled to network media supporting at least a high speed protocol and a lower speed protocol; and power management logic on the integrated circuit which forces the medium interface unit to the lower speed protocol in response to an event signally entry to the lower power mode. (Emphasis added).

Accordingly, the '875 Published Application cannot serve as an effective reference under 102(e) and withdrawal of the rejection is respectfully requested.

**CONCLUSION**

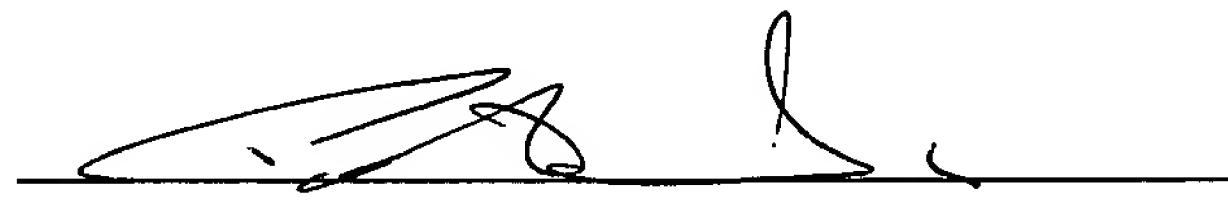
It is respectfully submitted that this application is now in condition for allowance, and such action is requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (3COM 3641-1).

Respectfully submitted,

Dated:

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**Amendments to the Drawings:**

The attached sheets of Replacement Sheets and Annotated Sheets Showing Changes in the Appendix include changes to Figure 1. These sheets replace the original sheets including Figures 1-2B as filed. In Figure 1, the reference number 17 has been added to the connector.

Attachments: Replacement Sheets (1-3)

Annotated Sheets Showing Changes

1/3

